

## REMARKS

This is a full and timely response to the final Office Action mailed on June 1, 2005 (Paper No./Mail Date 20050517). Reconsideration and allowance of the Application and presently pending claims are respectfully requested in view of the foregoing remarks.

### I. Interview Summary

Applicants first wish to express our sincere appreciation for the time that Examiner Bui spent with Applicants' attorneys, Minh Nguyen during a telephone discussion on August 18, 2005 regarding the outstanding final Office Action. The discussion involved claim 105 of the application, particularly the feature of enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories. During that conversation, an agreement was not reached because the Examiner alleges that U.S. Patent No. 6,735,572, to *Landesmann* discloses the feature of enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories. Applicants disagreed and provided reasons that *Landesmann* does not disclose that feature, similar to the response below. The Examiner indicated that another search for this feature may be conducted and if an Office Action is issued, it may be non-final.

### II. Response to Claim Rejections under 35 U.S.C. §103

Claims 105-106, 108-115, and 122-133 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Pub. No. 2003/0101454 to *Ozer, et al.* in view of U.S. Patent No. 6,735,572 to *Landesmann*. In order for a claim to be properly rejected under 35 U.S.C. §103, the teachings of the prior art reference must suggest all features of the claimed invention to one of ordinary skill in the art. *See, e.g., In re Dow Chemical*, 837 F.2d 469, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988); *In re Keller*, 642 F.2d 413, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981).

#### A. Claim 105

Claim 105, as amended, recites:

105. A method implemented by a television set-top terminal (STT) configured to provide television programs and a viewer's preference for advertisement categories, the method comprising:

configuring a memory in the STT to store the viewer's preference for advertisement categories;

receiving by a tuner in the STT at least one television program;

outputting to a television by the STT the at least one television program;

*providing a first-selectable option for the viewer's preference for advertisement categories;*

outputting to a television by the STT a graphical user interface (GUI) that comprises a plurality of viewer selectable advertisement categories, said plurality of viewer selectable advertisement categories including a first advertisement category and a second advertisement category that is different from the first advertisement category;

*receiving by the STT a first viewer input corresponding to the first advertisement category and a second viewer input corresponding to the second advertisement category;*

responsive to receiving the first and second viewer inputs, storing the first and second advertisement categories in the memory of the STT configured to store the viewer's preference for advertisement categories;

outputting to the television by the STT an advertisement based on the viewer's preference for advertisement categories, wherein the advertisement is output by the STT at a future time during an interruption in the presentation of the at least one television program being output by the STT.

(Emphasis Added)

- i. Ozer does not disclose and suggest providing a first-selectable option for viewer's preference that enables the viewer to view advertisements that correspond to an advertisement category selected by the viewer

Apparently, *Ozer* discloses in its Abstract as follows:

"A system, including a planning module, a control module and a receiver module, configured to schedule display of advertisements to achieve an advertising impression goal. The planning module enables scheduling of advertising impressions in accordance with target criteria. Further, the planning module enables selecting an advertising impression goal for advertisements, assigning an advertising type and defining a weight for the advertisement. The control module receives the schedule, the advertising type and the defined weights and generates one or more metadata files that contain target criteria, advertising type and weights for the advertisement.

***The one or more metadata files and advertising content for the advertisement, are delivered to the receiver module that is configured to define a display frequency for the advertising content based upon one or more of the metadata files. The receiver module selectively displays the advertising content of the advertisement to achieve the advertising impression goal.”***

(Emphasis Added)

Applicants respectfully submit that the *Ozer* receiver module does not allow the viewer to select an advertisement category to be included in a viewer's preference. The *Ozer* receiver module does not output advertisements based on the list of selected categories in the viewer's preference. Instead, the *Ozer* receiver module receives metadata files from the *Ozer* control module to selectively display the advertising content of the advertisement. The metadata files are defined in Paragraph 20 on page 2 of *Ozer* as:

“in a structured format, the time when the advertisement is to be displayed, the weight or display frequency of the advertisement, the duration of display of the advertisement, time-zone shifts to the display data, the advertisement content associated with the advertisement, and additional targeting information. Further, the metadata files include the type of advertisement where the advertising type indicates whether the advertisement is a committed advertisement or a flexible advertisement.”

*Ozer* further discloses in Paragraphs 22 and 23 on page 2-3 of *Ozer* as follows:

“Upon receipt of the advertisement content and the metadata, the receiver module deletes stored advertisement content and/or metadata files and substitutes the newly received advertising content and metadata files for the advertisement.

Subsequently, the receiver module displays the advertisement when needed by selectively displaying the advertisement's associated content based upon the target criteria, these absolute and relative weights, and whether the advertisement is committed or flexible advertisement.

Consequently, the planning module, the control module, and the receiver module can schedule and subsequently display advertisements, and more specifically the advertisement content associated with the advertisement, to a viewer, while the modules are intermittently connected one with another.”

In short, *Ozer* apparently discloses that the *Ozer* receiver module receives metadata from the *Ozer* control module that is located at a remote location and uses the metadata to selectively display the advertising content for the advertisement to a viewer. Accordingly, Applicants

respectfully submit that *Ozer* fails to disclose and suggest enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories. Thus, a *prima facie* case of obviousness cannot be established based on *Ozer*. Applicants respectfully request that claim 105 be allowed and the rejection be withdrawn.

- ii. *Landesmann* does not teach or disclose providing a first-selectable option for viewer's preference that enables the viewer to view advertisements that correspond to an advertisement category selected by the viewer

In fact, the *Landesmann* method for buyer-driven targeting is directed to the field of marketing, in particular, to the field of buyer-driven targeting of purchasing entities.

*Landesmann* discloses on column 11, line 40 to column 12, line 14 as follows:

The basic function performed by the system and method of the present invention is to allow buyer entities to submit their credit card statements and other records that detail past purchases to an entity that is preferably not affiliated with any particular merchant. Third party marketers/advertisers would then provide search criteria, or have search criteria selected for them, to search the database of past histories and offer highly attractive promotions to the group resulting from that search criteria. The past purchase history records could be supplemented by asking buyer entities questions about their past purchases, with the questions themselves chosen from a database of questions, with the selection of question being based on the purchase record earlier submitted by that buyer entity.

In one implementation, buyer entities would submit information on their credit card statements and other verifiable information on their past purchases ("purchase summaries") to the company. Note that such information could include frequent flyer purchase summaries or statements, telephone bills, etc. This information is then entered into an electronically searchable database. A unique membership ID could then be associated with each different buyer entity. The name, address, Email address and other personally identifiable information could be given a unique tag that would prevent it from being accessed during advertiser searches.

Alternatively, the personally identifiable information could be stored in a separate database, to prevent access by advertisers.

Buyer entities are tracked by the system via their membership ID.  
Advertisers and merchants may then select, via the designation of  
search criteria by or for them, groups of buyer entities who have  
the potential to become valuable customers on the basis of their  
purchase histories. The system of the present invention would then associate the selected group of buyer entities with their personally identifiable information and would send out offers, etc., from the advertiser, without the identities of the buyer entities being disclosed to the advertiser that set forth the search criteria. In essence, in order to acquire these particularly desirable buyer entities as customers, the advertiser has this independent system to communicate with this group of buyer entities on its behalf.

(Emphasis Added)

*Landesmann* appears to disclose a system that gathers scores related to the buyer's buying habits. The scores are obtained through the buying activities of buyer entities, particularly through the use of credit cards. The scores enable the *Landesmann* system to create certain criteria that determines what the buyer entities are buying and provide certain advertisements for products that are prone to be brought by the buyer entities. The *Landesmann* selected advertisements are stored or transmitted from the system to interactive TV units of the buyer's entities.

Applicants would like to point out Fig. 12 at Step 1210 of *Landesmann* which reads "access ad database, select advertisements to be stored on personal video recorder/interactive TV unit of viewer and any associated thresholds and rules therefor; determine sequence of advertisements to be shown or rules for selecting one of several advertisements; and optionally determine incentive levels to be displayed for various advertisements." (Emphasis Added). In addition, column 32, lines 7-32 of *Landesmann* describes Fig. 12 at Step 1210 as follows:

In block 1210, a data base of advertisements is accessed which advertisements are to be played, as well as any score thresholds associated with the individual advertisements or sets of advertisements and any rules associated with particular advertisements or sets of advertisements such as playing certain advertisements only with selected programs, or only at certain times of day, or only on certain days, or only for buyer entities with certain demographic characteristics. The advertisements are then selected and may also optionally be sequenced based on these rules, including rules for sequencing based on the buyer entity

scores. For example, information that a buyer entity is a regular viewer of Masterpiece Theater could be used in conjunction with a relatively high score in the category of luxury items, as determined for example by comparison of the buyer entity's luxury item score to a threshold set for a particular advertisement, to thereby select an advertisement for expensive jewelry, which advertisement will then be placed first in a sequence of advertisements. The demographic information that this buyer entity is in a high income zip code could also be used in conjunction with a high buyer entity score in the category of automobiles to then place an advertisement for automobiles second in the sequence of advertisements. This selection and sequence would be determined solely or in combination with other information such as viewing habits and demographic information. The particular sequence rules would be determined as desired.

(Emphasis Added)

Applicants respectfully submit that Step 1210 of Fig. 12 implies that the system is selecting the advertisements for buyer entities with certain demographic information and viewing habits. Nowhere does Landesmann disclose and suggest enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories. Landesmann appears to disclose and suggest that the system is selecting the type of advertisement, not the viewer. It further does not have selectable options that the viewer can select to determine which advertisement they want to view.

Accordingly, Applicants respectfully submit that *Landesmann* fails to disclose and suggest enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories, as recited in claim 105. Thus, a *prima facie* case of obviousness cannot be established based on *Landesmann*. Applicants respectfully request that claim 105 be allowed and the rejection be withdrawn.

iii. The combination of *Ozer* and *Landesmann* fails to disclose, teach, or suggest each and every element of claim 105

Because *Ozer* and *Landesmann* individually fail to disclose, teach, or suggest the above-emphasized features of claim 105, Applicants respectfully submit that the combination of *Ozer* and *Landesmann* also fails to disclose, teach, or suggest each and every element of claim 105. Thus, a *prima facie* case of obviousness is not established based on *Ozer* and *Landesmann*. Consequently, for at least this reason, among others, Applicants respectfully request that claim 105 be allowed and the rejection be withdrawn.

B. Claims 106 and 108-115

Dependent claims 106 and 108-115 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 105. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

C. Claim 122

Claim 122, as amended, recites:

A method implemented by a television set-top terminal (STT), comprising:

configuring the STT to receive a first plurality of advertisement data components corresponding to respective advertisements, each advertisement being corresponding to a respective advertisement category in a first plurality of advertisement categories;

*outputting to a television by the STT a graphical user interface (GUI) that comprises a plurality of selectable advertisement categories, wherein the first plurality of advertisement categories include the plurality of selectable advertisement categories;*

*receiving by the STT a plurality of viewer inputs respectively corresponding to viewer-selected advertisement categories from the plurality of selectable advertisement categories, wherein the viewer inputs are provided by a viewer of the television;*

responsive to receiving the plurality of viewer inputs, storing in a memory of the STT the viewer-selected advertisement categories; and

after receiving the plurality of viewer inputs, receiving by the STT advertisement data components corresponding exclusively to respective advertisements corresponding to the viewer selected advertisement categories.

(Emphasis Added)

As mentioned above with reference to claim 105, *Ozer* apparently discloses that the *Ozer* receiver module receives metadata from the *Ozer* control module that is located at a remote location and uses the metadata to selectively display the advertising content for the advertisement to a viewer. In addition, nowhere does *Landesmann* disclose and suggest enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories. *Landesmann* appears to disclose and suggest that the system is selecting the type of advertisement, not the viewer. It further does not have selectable options that the viewer can select to determine which advertisement they want to view.

Accordingly, Applicants respectfully submit that *Ozer* and *Landesmann* fail to teach or disclose enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories, as recited in claim 122. Thus, a *prima facie* case of obviousness cannot be established based on *Ozer* and *Landesmann*. Applicants respectfully request that claim 122 be allowed and the rejection be withdrawn.

#### D. Claims 123-127

Dependent claims 123-127 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 122. Supra. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600.

#### E. Claim 128

Claim 128, as amended, recites:

A method implemented by a television set-top terminal (STT), comprising:  
*outputting to a television by the STT a graphical user interface (GUI) that comprises a plurality of viewer-selectable advertisement categories; receiving by the STT a plurality of viewer inputs respectively corresponding to viewer-selected advertisement categories from the plurality of selectable advertisement categories, wherein the user inputs are provided by a viewer of the television; and*

*responsive to receiving the plurality of user inputs, outputting to the television by the STT a plurality of advertisements respectively corresponding to at least one of the viewer-selected advertisement categories.*

(Emphasis Added)

As mentioned above with reference to claim 105, *Ozer* apparently discloses that the *Ozer* receiver module receives metadata from the *Ozer* control module that is located at a remote location and uses the metadata to selectively display the advertising content for the advertisement to a viewer. In addition, nowhere does *Landesmann* disclose and suggest enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories. *Landesmann* appears to disclose and suggest that the system is selecting the type of advertisement, not the viewer. It further does not have selectable options that the viewer can select to determine which advertisement they want to view.

Accordingly, Applicants respectfully submit that *Ozer* and *Landesmann* fail to teach or disclose enabling the viewer to select advertisement categories via a graphical user interface and television set-top terminal (STT) and to view advertisements based on the viewer's selected advertisement categories, as recited in claim 128. Thus, a *prima facie* case of obviousness cannot be established based on *Ozer* and *Landesmann*. Applicants respectfully request that claim 128 be allowed and the rejection be withdrawn.

F. Claims 129-133

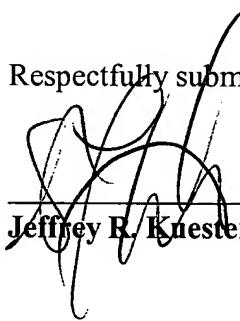
Dependent claims 129-133 are believed to be allowable for at least the reason that these claims depend from allowable independent claim 128. Supra. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1600.

## CONCLUSION

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well-known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions.

In light of the foregoing remarks and for at least the reasons set forth above, Applicants respectfully submit that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
\_\_\_\_\_  
**Jeffrey R. Knester, Reg. No. 34,367**

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500